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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,939	02/11/2004	Mark Siegel	115438-215	5348

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Bell, Boyd & Lloyd LLC  
P.O. Box 1135  
Chicago, IL 60690-1135

EXAMINER

BROCKETTI, JULIE K

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/777,939

Applicant(s)

SIEGEL ET AL.

Examiner

Julie K Brockett

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

The declaration filed on February 11, 2004 lists the proper residences of the inventors; however, this declaration was never signed. The declaration filed on April 22, 2004 was signed, but the residences are listed as merely "US".  
The city and state of residence is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3, 5-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Molinaroli, U.S. Patent No. 6,265,984 B1.** Molinaroli discloses an electronic game. The device includes a base and a spinning unit affixed to the base and adapted to spin relative thereto. The spinning unit includes a display mechanism adapted to display text that dictates actions to be taken in the game (See Molinaroli col. 15 lines 35-57; col. 16 lines 12-49; Figs. 18-20, 26). A circuit controls the display mechanism. A sensor including a magnet is disposed in the base and a magnetic switch is disposed in the spinning unit for communicating with the circuit. The circuit triggers the display mechanism based on the communications from the sensor independent of a minimum speed requirement (See Molinaroli col. 3 lines 58-62; col. 6 lines 29-42; col. 8 lines 57-67; col. 15 lines 53-55; col. 16 lines 50-55) [claim 1]. The display mechanism includes light emitting diodes (See Molinaroli col. 4 lines 38-39) [claim 2]. The spinning unit includes a speaker (See Molinaroli col. 7 lines 1-4) [claim 3]. The spinning unit has a handle (See Molinaroli col.

Art Unit: 3713

25 lines 27-31) [claim 5]. The handle includes at least one control button (See Monetarily Fig. 3) [claim 6]. The spinning unit is translucent plastic (See Molinaroli col. 15 lines 31-36; col. 16 lines 12-14) [claim 7]. The circuit is disposed in the spinning unit (See Molinaroli col. 15 lines 58-67; col. 16 lines 50-67) [claim 8]. The circuit is a microprocessor (See Molinaroli col. 16 lines 50-67) [claim 9]. The display mechanism is a single row of light emitting diodes (See Molinaroli Figs. 15-20) [claim 10]. The single row of light emitting diodes extends from an outer periphery of the spinning unit towards the center of the spinning unit (See Molinaroli Figs. 15-20) [claim 11]. The single row includes seven light emitting diodes (See Molinaroli Figs. 15-20) [claim 12]. The spinning unit is substantially circular and the single row extends along a radial line thereof (See Molinaroli Figs. 15-20) [claim 13].

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation *Ex parte Masham*, 2 USPQ2d 1647 (1987). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Hence the recitation that the device be employed in a specific manner

regarding the actions of the structure does not differentiate the claimed apparatus from the Molinaroli apparatus, which satisfies the claimed structural limitation. Additionally, the Applicant is invited to review MPEP §2114 R-1 which states: MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Additionally, the MPEP §2114 R-1 clarifies that an apparatus claim is drawn to the structure of the device, not the function, by stating "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

Regarding claims 1, the claims are intended use as discussed above. The Examiner invites the Applicant to review MPEP §2106 II-C which states: The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or *does not limit a claim to a particular structure does not limit the scope of a claim* or claim limitation. The

Art Unit: 3713

following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive.

**Claims 14-19, 22-26 and 28-34 are rejected under 35 U.S.C. 102(b) as being anticipated Capps et al, U.S. Patent No. 5,791,966.** Capps discloses an electronic game. It has a base and a spinning body adjacent to the base and adapted to rotate relative thereto (See Capps Fig. 1). A display mechanism is disposed in the spinning body and adapted to display a text message when the spinning body is rotating (See Capps Fig. 8). A circuit is in electrical communication with the display mechanism and adapted to communicate the text to be displayed (See Capps col. 4 lines 52-63). A sensor including a magnet and a magnetic switch is in electrical communication with the circuit. It is adapted to communicate to the circuit when the spinning body is rotating, thereby effecting initiation of the text display (See Capps col. 6 lines 19-28) [claims 14, 29]. The sensor is configured such that it can determine the rotational speed at which the spinning body is rotating, thereby effecting regulation of the text display (See Capps col. 8 lines 34-67) [claim 15]. The spinning body is coupled to the base (See Caps Fig. 1) [claim 16]. The spinning

body is substantially surrounded by the base (See Caps Fig. 1) [claim 17]. For example, in Figure 1, item 105 can be considered to be the base and item 103 can be considered the spinning body. In another embodiment, the magnet is disposed in the base and the magnetic switch is disposed in the spinning body (See Caps col. 6 lines 16-23) [claim 18]. The display mechanism includes seven light emitting diodes in a single row that extends from an outer periphery of the spinning body towards the center of the spinning body (See Capps col. 7 lines 57-59; Fig. 1) [claims 19, 22, 23, 24, 30, 31]. The spinning body is substantially circular and the single row extends along a radial line thereof (See Capps Fig. 1) [claims 25, 31]. The spinning body includes a handle (See Capps Fig. 1) [claim 26]. Capps discloses a method of displaying text for an electronic gaming device. The gaming device has a spinning unit and a base. The spinning unit is rotated relative to the base. A sensor generates information by determining when the spinning unit makes a complete revolution and the rate at which the spinning unit revolves. A text display is initiated based on the information from the sensor (See Capps col. 8 lines 34-67; Fig. 1) [claim 28]. The text display is regulated using the information from the sensor and the regulating step includes regulating the text display using the rate at which the spinning unit revolves (See Capps col. 8 lines 34-67) [claims 32, 33]. Capps discloses a method of playing an electronic game with a spinning display. A body that is coupled to a base is spun. The body includes at least two lights positioned thereon. A magnetic sensor is activated if it



determines that the body is spinning relative to the base. A text display formed by the lights positioned on the spinning body being selectively activated when the sensor indicates that the body is spinning is read and action is taken dependent upon the text display (See Capps col. 1 lines 49-67; col. 2 lines 1-40) [claim 34].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Molinaroli in view of Reinberg et al., U.S. Patent No. 6,692,328 B1.**

Molinaroli lacks in disclosing a microphone. Reinberg teaches of a toy that includes a microphone for recording sounds to be played with a speaker (See col. 4 lines 64-67; col. 5 lines 1-6) [claim4]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a microphone in the device of Molinaroli. By including a microphone, users can record their own personal messages to be heard thereby personalizing the device and providing further entertainment to the user.

**Claims 20 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capps in view of Molinaroli, U.S. Patent No. 6,265,984**

**B1.** Capps lacks in disclosing a speaker and a control button. Molinaroli discloses a spinning device with lights that includes a speaker (See Molinaroli col. 7 lines 1-4) [claim 20]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a speaker in the toy of Capps. By having a speaker, players can hear sounds as they play with the toy, which makes the toy more enjoyable to the player. Furthermore, the player could hear the words that are being displayed. Molinaroli further discloses a control button on the handle (See Molinaroli Fig. 3) [claim 27]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a control button on the handle of Capps' invention. By including a control button on the handle, players can easily access the control button to input their words into the device or turn the device on or off.

**Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Capps in view of Molinaroli, in further view of Reinberg et al., U.S.**

**Patent No. 6,692,328 B1.** Capps and Molinaroli lack in disclosing a microphone. Reinberg teaches of a toy that includes a microphone for recording sounds to be played with a speaker (See col. 4 lines 64-67; col. 5 lines 1-6) [claim 21]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a microphone in the device of

Art Unit: 3713

Capps or Molinaroli. By including a microphone, users can record their own personal messages to be heard thereby personalizing the device and providing further entertainment to the user.

### ***Citation of Relevant Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Nelson, U.S. Patent No. 6,325,690 B1.
2. Altman, U.S. Patent No. 6,486,858 B1.
3. Nobile et al., U.S. Patent No. 5,057,827.
4. Tokimoto et al., U.S. Patent No. 5,406,300.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Julie K Brockett  
Examiner  
Art Unit 3713